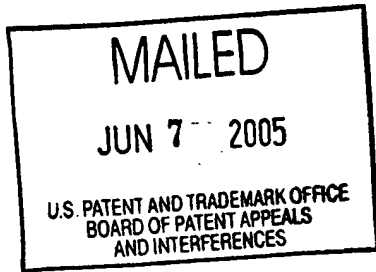


THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH A. McCLUSKEY, RONALD E. PAULSON,
SANDRA SKILLEN, ALISA LYNN FIFIELD and ALEX ZELINSKI

Appeal No. 2005-0967
Application No. 09/705,559

ORDER REMANDING TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on February 25, 2005. A review of the application has revealed that the application is not ready for a decision on appeal. Accordingly, the application is herewith being remanded to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the file indicates that the Examiner failed to deal with the 35 U.S.C. § 101 issues as stated in the Reply Brief filed on December 6, 2004. Appellants stated in the Reply Brief on page 2, that during a phone conference with the Examiner prior to responding to the Office Action of May 28, 2004, the rejection under 35 U.S.C. § 101 was discussed with the Examiner and the Examiner agreed that the rejection under 35 U.S.C. § 101 was in

error, and the Examiner agreed to withdraw these grounds of rejection. This has not been done, and the Appellants continue to believe that the rejection under 35 U.S.C. § 101 was made in error, and to the extent that it was not previously withdrawn, must be withdrawn as a result of this appeal.

Further, appellants filed the Appeal Brief on September 20, 2004 using the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the Appeal Brief filed on September 29, 2004 does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37 states:

- (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.
- (2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).
- (b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.
- (c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:
 - (i) *Real party in interest.* A statement identifying by name the real party in interest.
 - (ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a

court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any

argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix*. An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph

(c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

Upon an in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief of September 20, 2004:

- 1) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37 (c) (1) (v);
- 2) "Evidence Appendix", as set forth in 37 CFR § 41.37(c) (1) (ix); and
- 3) "Related Proceedings Appendix", as set forth in 37 CFR § 41.37(c) (1) (x).

A substitute brief that is in compliance with § 41.37(c) is required. For more information see United States Patent and Trademark website www.uspto.gov, in particular the web page entitled More Information on the Rules of Practice Before the BPAI, Final rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Accordingly it is


ORDERED that the application is electronically remanded to the Examiner to:

- 1) to set forth the status of the 35 U.S.C. § 101 rejection;
- 2) hold the Appeal Brief of September 29, 2004 defective;
- 3) for applicant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;

- 4) for the examiner to consider the substitute Appeal Brief, and if necessary to vacate the Examiner's Answer mailed November 23, 2004, and issue a new Examiner's Answer; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:

A handwritten signature in dark ink, appearing to read 'Dale M. Shaw', is written over a horizontal line.

DALE M. SHAW
Program and Resource Administrator
(571) 272-9797

DMS/gjh

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